In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-152

JOSEPH M. RICE, PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

The Court of Customs and Patent Appeals affirmed the decision of the Patent Office rejecting petitioner's patent application claims on the grounds that they were anticipated by prior art (35 U.S.C. 102) and did not comply with the specificity requirement of the second paragraph of 35 U.S.C. 112. Petitioner contends that the court erred in so doing.

1. Petitioner filed a nine claim application for a patent on a stereophonic AM (amplitude modulated) transmitting and receiving system. The Patent Office examiner rejected the application as submitted but noted that three of the claims would be allowable if amended. Instead of following this recommendation,

petitioner requested that all nine claims be withdrawn and two new claims be substituted in their place.[1] The substitution was made. Subsequently, on September 18, 1970, the Patent Office rejected the claims on the grounds that they were anticipated by prior art (R. 16) and that they did not satisfy the specificity requirement of 35 U.S.C. 112; *viz.*, the claims "neither specify a method for arriving at a particular result nor do they define any apparatus to carry out the idea present" (R. 18). Petitioner then sought to amend his application with four new claims. His request was denied by the Assistant Commissioner of Patents because "[t]he proposed amendment was not accompanied by any showing of good and sufficient reasons why the amendment was necessary * * * as required by Rule 116(b) of the Patent Office Rules of Practice." The Assistant Commissioner also concluded that "the [new] * * * claims * * * did not * * * render the existing claims allowable or in better condition for appeal" (Brief for the Commissioner of Patents, App. A2—Letter of July 28, 1972).

The Board of Appeals affirmed (R. 53-56). It noted that " * * * claims 1 and 2, * * * are anticipated by any one of the patents to Kidd, Jenkins, and Van Der Muelen"

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[1]The claims are set forth on page 95 of the Transcript of Record in the court below. The reference "R." throughout this memorandum is to that Record. Copies of the record and the opinion of the Court of Customs and Patent Appeals are being lodged with the Clerk of this Court.

(R. 55). With respect to the specificity requirement, the Board stated (R. 54):

> Appellant does not claim a series of steps which form the method of his invention, nor does he claim the apparatus which he considers to be his invention. Rather, appellant appears to claim the *purpose* of his invention.

The Board granted a request for reconsideration to consider petitioner's assertion that his proposed amendment was wrongly excluded. The Board held that the amendment was not properly before it since it was not entered by the examiner and was not mentioned in the notice of appeal (R. 60).

The Board's decision was upheld by the Court of Customs and Patent Appeals, which ruled that the application was anticipated by prior art; *i.e.*, "Each reference discloses '[a] system of switching simultaneously a plurality of information such as is needed for the transmission and reception of stereo using the carrier itself for the synchronizing of the receiver with the transmitter,' as stated in the first portion of claim 1. * * * claim 2 also has not been shown to distinguish over the references" (Opinion p. 1). Moreover, the court held that the claims did not meet the specificity requirement as they failed "to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112" (Opinion, p. 2). Furthermore, the court determined that the "claims do not define appellant's invention in a manner that makes clear what subject matter they encompass, an essential requirement for meeting the provisions of

section 112. See *In re Hammack,* * * * 427 F. 2d 1384 * * * (CCPA 1970)" (Opinion, p. 3). Finally, the court concluded that "[t]he other claims, submitted by appellant after final rejection, are not before us because the board did not act on them and the Assistant Commissioner denied a petition for their entry in the application" (Opinion, p. 3).

2. Petitioner's main argument apparently is that the Patent Office erred in refusing to allow him to amend his application (Pet. 6-7, 8, 23). This assertion is without merit. Petitioner admits that the proposed amendment was sent to the Patent Office in December, 1970 (Pet. 5-6), *after* a final rejection by the examiner (decision of September 18, 1970). The refusal of an examiner to enter an amendment after final rejection is a matter of discretion (*Application of Mindick,* 371 F. 2d 892 (C.C.P.A.); 37 C.F.R. §1.116(b), and judicial review of such action may be had only in the district court, not the Court of Customs and Patent Appeals. *Application of Mindick, supra,* 371 F. 2d at 894; 35 U.S.C. 141, 145.

In addition, petitioner repeats his contention that the claims are not anticipated by prior art (Pet. 8-9, 11). In an attempt to distinguish his claims from the three references relied upon below, petitioner argues that the Patent Office did not understand his claim (Pet. 11, 13) and that the Patent Office misconstrued his use of the word "carrier" (Pet. 10, 25). This argument is also without merit. The Patent Office, the Board of Appeals, and the Court of Customs and Patent Appeals carefully considered petitioner's claims and unanimously concluded that he had failed to distinguish

his claims from the references. Indeed, as previously noted, the Court of Customs and Patent Appeals held:

> Each reference discloses "[a] system of switching simultaneously a plurality of information such as is needed for the transmission and reception of stereo using the carrier itself for the synchronizing of the receiver with the transmitter," as stated in the first portion of claim 1. * * * [C]laim 2 also has not been shown to distinguish over the references. [Opinion, p. 1.]

The findings set forth in the opinions below, upon which we rely, plainly establish that petitioner's claims were properly rejected as anticipated by prior art.

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

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